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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/647,086	09/26/2000	Yuji Sawada	55168(55)	4078
21874 7590 07/23/2008 EDWARDS ANGELL PALMER & DODGE LLP P.O. BOX 55874 BOSTON, MA 02205				
EXAMINER DESHPANDE, KALYAN K				
ART UNIT		PAPER NUMBER		
3625				
MAIL DATE		DELIVERY MODE		
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Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary

Application No.

09/647,086

Applicant(s)

SAWADA ET AL.

Examiner

Kalyan K. Deshpande

Art Unit

3625

Period for Reply -- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 09 April 2008.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☐ Claim(s) 1-30 is/are pending in the application.
- 4a) Of the above claim(s) 1-19, 29 and 30 is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 20-28 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 26 September 2000 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO/SB/C)
- Paper No(s)/Mail Date 1/11/08 & 4/9/08
- 4) ☐ Interview Summary (PTO-413)
- Paper No(s)/Mail Date _____
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: _____

DETAILED ACTION

Introduction

The following is a non-final office action in response to the communications received on April 9, 2008. Claims 20-28 are now pending in this application.

Information Disclosure Statement

The examiner has reviewed the patents and articles supplied in the Information Disclosure Statements (IDS) provided on January 11, 2008 and April 9, 2008.

Response to Amendments

Applicants' amendments to claims 20 and 25 are acknowledged.

Response to Arguments

Applicants' arguments have been fully considered but are not found persuasive. Applicants argues i) Examiner has failed to re-acknowledge Applicants' claim for priority, ii) Examiner has failed to reconfirm the drawings are accepted, iii) Examiner has failed to consider JP 6-85916 per accompanied 1449, iv) Fujimoto fails to teach "the reproduction of digital data from an external storage medium", and v) Fujimoto fails to teach claim 25.

In response to Applicants' argument "Examiner has failed to re-acknowledge Applicants' claim for priority", Examiner respectfully submits this argument is moot. Examiner has acknowledged Applicants' request for priority in the Final Office Action submitted on April 8, 2004. Examiner maintains that any subsequent re-acknowledgement is neither required nor necessary.

In response to Applicants' argument "Examiner has failed to reconfirm the drawings are accepted", Examiner respectfully submits this argument is also moot. Examiner confirmed that the drawings were accepted in the Non-Final Office Action submitted on November 18, 2003. Examiner maintains that any subsequent re-confirmation is neither required nor necessary.

In response to Applicants' argument "Examiner has failed to consider JP 6-85916 per accompanied 1449", Examiner notes that no 1449 form includes the reference JP 6-85916. The accompanying IDS letter includes reference JP 5-85196, however, this reference will not be considered because no translation to English of this reference has been provided. As such, Examiner is considering the IDS form as submitted. Applicants are encouraged to submit an IDS containing all of the proper document numbers so that they can be properly considered.

In response to Applicants' argument Fujimoto fails to teach "the reproduction of digital data from an external storage medium" (see Remarks p. 26 first full paragraph and p. 28 last paragraph), Examiner respectfully disagrees. Applicants' arguments are confusing and contradictory. Applicants' appear to be arguing that Fujimoto discloses a system where there is a transfer of digital data from a source to a destination, which is distinguished from "the reproduction of digital data from an external storage medium". Applicants provide selections from the Specification describing a system where the transfer of data only occurs after ID information is known (see Remarks p. 25). This is the same as in Fujimoto where a purchaser's identification information is collected and verified prior to the production of content data. Applicants appear to be conceding that

Fujimoto teaches this capability (see Remarks p. 27 last paragraph). Based on the arguments Applicants' have provided, it is unclear as to exactly what Applicants are arguing as the distinction between Fujimoto and the present invention. If Applicants' persist in the argument, Examiner requests that Applicants' clearly and expressly state their reasons as to how the present invention is distinguished from the cited prior art. Examiner maintains that Fujimoto directly reads upon the limitations recited in claims 20-28.

In response to Applicants' argument Fujimoto fails to teach claim 25, Examiner respectfully disagrees. Claim 25 recites limitations that are already addressed by the rejection of claim 20; therefore the same rejections apply to this claim.

Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

Claims 20-28 are rejected under 35 U.S.C. 102(e) as being anticipated by Fujimoto (U.S. Patent No. 6,018,720).

Referring to claim 20. Fujimoto discloses a data reproducing apparatus reproducing digital data including reproducing apparatus specifying information for specifying an apparatus capable of reproduction, comprising:

a housing containing:

a storage apparatus storing reproduction apparatus ID information unique to said reproducing apparatus (Fig. 2, "13");

means for reading out said digital data from said storage media, wherein said media includes a data region storing said reproducing apparatus specifying information (column 9, lines 40-64);

a first determining apparatus determining whether said reproducing apparatus is capable of reproducing said digital data from said reproduction apparatus ID information and said reproducing apparatus specifying information (column 11, lines 23-45);

a control apparatus enabling or disabling reproduction of digital data by said reproducing apparatus dependent on the result of determination by said first determining apparatus (column 13, lines 19-49) and

a CPU directly controlling the manner of operation of said storage apparatus, said first determining apparatus, and said control apparatus as well as the reproduction of said digital data enabled by said control apparatus as audio and/or video signals (Fig. 1, "24").

Referring to claim 21. Fujimoto further discloses a data reproducing apparatus wherein:

said digital data includes display data to be reproduced visually (column 8, lines 15-48); and

said reproducing apparatus comprises a display apparatus for visually reproducing and displaying said digital data (column 8, lines 15-48).

Referring to claim 22. Fujimoto further discloses a data reproducing apparatus further comprising an ID information input apparatus responsive to determination by said first determining apparatus that said reproducing apparatus is not a reproducing apparatus capable of reproducing said digital data, urging a user to enter a reproducing apparatus ID information (column 11, lines 23-45).

Referring to claim 23. Fujimoto further discloses a data reproducing apparatus comprising:

a second determining apparatus determining whether the data reproducing apparatus specified by the reproducing apparatus ID information input by said ID information input apparatus is a reproducing apparatus capable of reproducing said digital data; wherein said control apparatus enables or disables reproduction of digital data by said reproducing apparatus dependent on the result of determination by said second determining apparatus (column 11, lines 23-45 and column 13, lines 19-49).

Referring to claim 24. Fujimoto further discloses a data reproducing apparatus comprising:

an update selecting apparatus responsive to the determination by said second determining apparatus that the data reproducing apparatus specified by the reproducing apparatus ID information input by said ID information input apparatus is a reproduction apparatus capable of reproducing said digital data, allowing the user to select whether said reproducing apparatus specifying information is to be updated by said input reproducing apparatus ID information (column 13, line 49 through column 14, line 5); and

an updating apparatus responsive to the selection, by said update selecting apparatus that said reproducing apparatus specifying information is to be updated by said reproducing apparatus specifying information by said input reproducing apparatus ID information (column 13, line 49 through column 14, line 5).

Referring to claims 25-26. Claims 25-26 are rejected under the same rationale as set forth above in claims 20-24.

Referring to claim 27. Fujimoto further discloses a data reproducing apparatus wherein said reproducing apparatus specifying information is recorded when reproduction is first performed by the data reproducing apparatus (abstract).

Referring to claim 28. Fujimoto further discloses a data reproducing apparatus wherein said reproducing apparatus specifying information is recorded when the digital data is sold (abstract).

Conclusion

THIS ACTION IS MADE FINAL. Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Kalyan K. Deshpande whose telephone number is (571)272-5880. The examiner can normally be reached on M-F 8am-5pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Jeff Smith can be reached on (571) 272-6763. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

/Jeffrey A. Smith/
Supervisory Patent Examiner, Art
Unit 3625

/KKD/